

REMARKS

In response to the non-final Office Action mailed on November 24, 2004, Applicant respectfully requests reconsideration of all rejections in the outstanding Office Action in view of the following remarks. Claims 1-11 and 13-28 are currently pending.

I. The Cited References Fail to Disclose a “Second Random Number”

Claims 1 and 19 both recite “generating a second random number.” Claim 1 further recites “transmitting a second challenge to said computing device, wherein said second challenge comprises said encrypted second random number.” Claim 19 recites “transmitting a second challenge to said computing device, wherein said second challenge comprises ... said second random number.” The cited references, Pitchenik *et al.* (“Pitchenik”), Kimura, and Shteyn, fail to disclose these limitations.

Pitchenik does not consider, discuss, suggest, or in any way refer to a second random number. The various embodiments disclosed by Pitchenik include at most a single random number. The claimed limitation of “generating a second random number” is simply absent from the Pitchenik disclosure. Furthermore, none of the Pitchenik embodiments send a second challenge including a second random number to a computing device. The claim limitations of “transmitting a second challenge to said computing device, wherein said second challenge comprises said encrypted second random number” and “transmitting a second challenge to said computing device, wherein said second challenge comprises ... said second random number” are entirely absent from the Pitchenik disclosure. Pitchenik therefore cannot properly be relied upon to reject claims 1 and 19. Because Pitchenik fails to disclose a “second random number” included in a “second challenge,” the rejection is improper and should be withdrawn.

Kimura does not make up for Pitchenik’s omission. In particular, Kimura fails to disclose a second random number and fails to disclose “transmitting a second challenge to said computing device, wherein said second challenge comprises said encrypted second random number” and “transmitting a second challenge to said computing device, wherein said second challenge comprises ... said second random number.” At most, Kimura discloses a single random number. Nowhere does Kimura consider, discuss, suggest, or in any way refer to a

second random number. It is therefore improper to rely on Kimura, and Applicant accordingly requests that the rejection be withdrawn.

Shteyn also fails to disclose “generating a second random number.” To the contrary, Shteyn is directed to traditional WEP authentication, which lacks a second random number as claimed. *See* Shteyn, paragraphs 19-20. The present application is directed to overcoming certain disadvantages of WEP. *See* the present application, paragraphs 6-9. Moreover, Shteyn makes absolutely no mention of a “second random number.” Due to the complete absence of any teaching, suggestion, consideration, discussion, or reference to a “second random number,” in Shteyn, any reliance on the same would be improper. Applicant accordingly requests that the rejection be withdrawn.

Under 35 U.S.C. § 102, anticipation requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131 reinforces this principle: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Because the cited references fail to disclose a “second random number” as claimed, the rejection is improper and must be withdrawn.

The claims dependent on claim 1 and 19 are allowable at least by virtue of their dependency on claims 1 and 19. Applicant accordingly requests that the rejection of the claims dependent on claims 1 and 19 be withdrawn.

II. The Cited Reference Fails to Disclose a “Physical Token”

Claim 13 recites a “unique tamper-resistant physical token comprising a random number generator, a unique secret cryptographic key, and a unique serial number.” The cited reference, Pitchenik, Kimura, and Shteyn have absolutely no teaching of this limitation.

Pitchenik does not consider, discuss, suggest, or in any way refer to a “unique tamper-resistant physical token.” The limitation is simply not there. Pitchenik has absolutely no teaching, suggestion, consideration, discussion, or reference concerning a “physical token.” As set out in the present application, the “physical token” is a separate device: “The present invention [uses] ... physical keys in the form of easy-to-use adapters that attach to existing

computing devices and wireless access points... These physical keys are secure, tamper resistant physical tokens.” Present application, paragraph 36. Pitchenik has absolutely no teaching of such a physical token. In fact, Pitchenik has no teaching of any separate device comprising “a random number generator, a unique secret cryptographic key, and a unique serial number,” as claimed. Pitchenik has absolutely no teaching, suggestion, consideration, discussion, or reference concerning anything that is “tamper resistant.” Pitchenik cannot, therefore, be properly relied upon to reject claim 13. Because Pitchenik lacks any teaching regarding a “unique tamper-resistant physical token,” the rejection is improper and should be withdrawn.

Kimura also fails to disclose a “unique tamper-resistant physical token.” Kimura is utterly silent with respect to this limitation. In no way does Kimura consider, discuss, suggest, or refer to a “unique tamper-resistant physical token.” In the complete absence of any teaching of “unique tamper-resistant physical token” by Kimura, any reliance on the same to reject the pending claims would be improper. Applicant accordingly requests that the rejection be withdrawn.

Shteyn, too, fails to disclose “unique tamper-resistant physical token comprising a random number generator, a unique secret cryptographic key, and a unique serial number.” At most, Shteyn discloses a “dongle,” which is not even described as being “tamper resistant,” let alone containing a “random number generator, a unique secret cryptographic key, and a unique serial number.” *See* Shteyn, paragraph 27. Shteyn does not teach, consider, discuss, suggest, or in any way refer to any type of tamper resistance. Nor does Shteyn teach, consider, discuss, suggest, or in any way refer to a physical token that comprises a “random number generator,” a “unique secret cryptographic key,” and a “unique serial number.” In the complete absence of such teaching, any reliance on Shteyn would be misplaced. Applicant accordingly requests that the rejection be withdrawn.

As the Examiner is well aware, anticipation under 35 U.S.C. § 102 requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131 reinforces this principle: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Because the cited references fail to disclose

a “unique tamper-resistant physical token comprising a random number generator, a unique secret cryptographic key, and a unique serial number” as claimed, the rejection is improper and must be withdrawn.

The claims dependent on claim 13 are allowable at least by virtue of their dependency on claim 13. Applicant accordingly requests that the rejection of the claims dependent on claim 13 be withdrawn.

III. The Office Action in General

Because the Examiner has cited portions of the references that disclose multiple embodiments, Applicant notes that different embodiments in the same reference may not be combined piecemeal under 35 U.S.C. § 102. Regarding claim 1, for example, the Examiner cites Pitchenik, col. 2, l. 40 - col. 3, l. 28 and col. 4, ll. 32-67. These passages refer to no less than five (5) different embodiments. In order to support a rejection under 35 U.S.C. § 102, every element of the claimed invention must be literally present, arranged as in the claim. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ at 673 (Fed. Cir. 1984); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 USPQ 781, 789 (Fed. Cir. 1983). Multiple embodiments do not support a rejection under § 102, which requires that the identical invention be shown in as complete detail as is contained in the patent claim. *See Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 USPQ 253, 255 (Fed. Cir. 1985). Applicant accordingly requests that the Examiner specify exactly which single embodiment of the cited reference is relied upon in forming any rejection under § 102.

VII. Conclusion

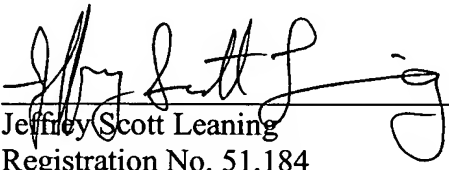
In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below-listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

No fee is believed to be required for entry and consideration of this timely Reply. Nevertheless, in the event that the U.S. Patent and Trademark Office requires a fee to enter this Reply or to maintain the present application pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
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Dated: March 23, 2005

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